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| 10/552,370      | 07/26/2006  | Takashi Nakano       | 279330US3PCT        | 1876             |

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

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| EXAMINER |
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NGUYEN, THUKHANH T

|          |              |
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| ART UNIT | PAPER NUMBER |
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1791

|                   |               |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

09/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/552,370   | <b>Applicant(s)</b><br>NAKANO ET AL. |  |
|                              | <b>Examiner</b><br>THU KHANH T. NGUYEN | <b>Art Unit</b><br>1791              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-13, and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al.(5,840,351).

Inoue et al. disclose a mold, comprising two split mold segments which are mated in a separable manner to define a spherical mold cavity therein (abstract; Fig. 1, # 1-2), wherein one split mold segment (2) has larger surface area in the recess thereof than the other split segment (1), wherein a split line (6) for splitting the mold segments (1, 2) are located at 0.1 to 5 mm off the equator/median line of the mold cavity (col. 2, lines 48-52), thus this split line would

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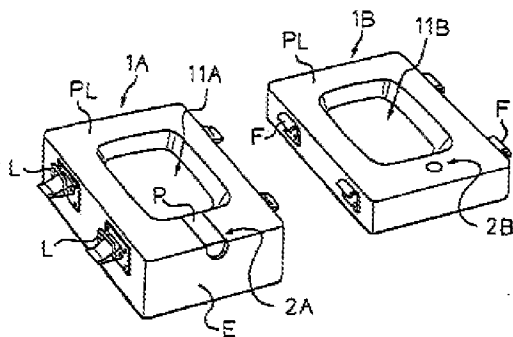
inherently divide the split mold segments into 52:48 to 66:34 range, and wherein neither mold segments (1, 2) includes an undercut.

The intended use of the mold for making soap has little or no patentability weight in determine the patentability of apparatus claims. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

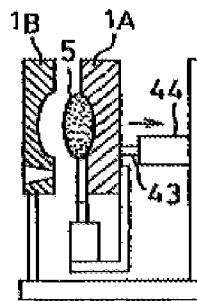
3. Claims 1-2 are again rejected under 35 U.S.C. 102(e) as being anticipated by Shimada et al (7,037,885).

Shimada et al teach a soap molding apparatus, comprising a split mold (1) having a first larger half (Fig. 2, 1A) and a second smaller half (1B), wherein the mold are capable of splitting at ratio are within the range of 52:48 and 66:34 (see Figs. 2-3).

Although Shimada's specification silent on the surface area of the mold halves, the drawings clearly indicate that one mold half is larger than the other, and is within the range of 52:48 (almost 1:1) to 66:34 (or 2:1). Copies of different embodiments are provided below:



Mold halves ratio is closer to 2:1



Mold halves ratio is closer to 1:1

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The court has held that drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). In this case, Shimada clearly show that the mold halves are splitted with in the range of 52:48 to 66:34. Shimada does not disclose an undercut.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (174,365) in view of Hobson (4,178,003).

Jackson discloses a soap mold, comprising first and second mold halves for forming spherical soap balls (Fig. 2, b-b), wherein the molded soap balls stay with one of the mold half after forming (col. 2, 2<sup>no</sup> paragraph).

However, Jackson fails to disclose that the mold halves are split at a ratio of 52:48 to 66:34.

Hobson discloses a molding apparatus, having upper mold (22) and a lower mold (24), wherein the mold cavity (28) formed in the upper mold (22) is less than one-half of the forming product, while the mold cavity (30) formed in the lower mold forms the greater portion of the product (24; col. 3, lines 50-54), this mold design facilitates a tolerance in the making and alignment of the molds, without sacrifice in quality of the forming product (col. 3, line 55 to col. 4, line 4). Since the range of 52:48 to 66:34 is large, when the parting line of the mold halves is

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off the center line and able to create two halves of a product that has one is slightly larger than the other, it would inrently fall within this range.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Jackson by providing one mold half is slightly larger than the other mold half as taught by Hobson so that the mold can be more tolerance in misalignment or inaccuracy in the sizing of the mold halves without sacrifice in accuracy of the forming product.

6. Claims 3-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al ('351), Shimada et al (885), or over Jackson ('365) and Hobson ('003) as applied to claims 1-2 above, and further in view of the Japanese reference (JP 2002-121599).

Shimada, Jackson and Kudriavetz fail to disclose that the split molds having a roughness between 0.01 to 30 gm.

The JP reference discloses a mold for forming soap, comprising upper mold (24) and lower mold (21), wherein the molds have a roughness between 0.01 to 30 gm (paragraph [0013] & the abstract) in order to form a smooth surface on the forming product while not interfere with product retention and/or removal.

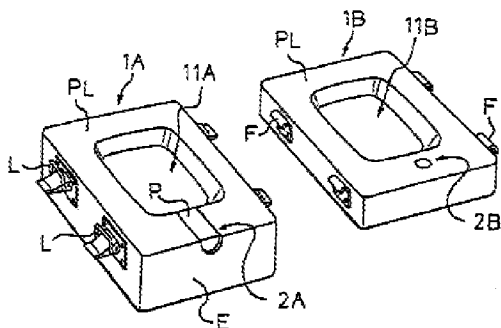
It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Shimada, Jackson and Kudriavetz by providing mold halves having roughness of between 0.01 to 30 gm as taught by the JP reference in order to form a smooth surface on the forming product.

***Response to Arguments***

7. Applicant's arguments filed 06/08/09 have been fully considered but they are not persuasive.

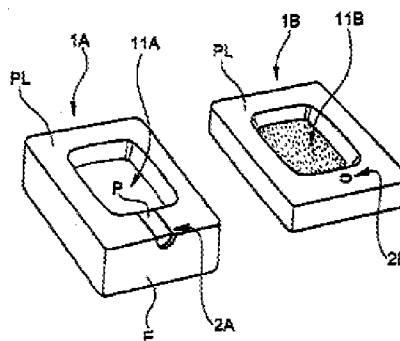
8. The Applicant argued that Shimada is silent with respect to the surface area of the depressions 11A and 11B of the first mold piece 1A and the second mold piece 1B. However, drawings (Figs. 3a-d) from Shimada clearly indicate that one mold piece could be slightly larger than the other mold piece, which is closer to the mold ratio of 52:48, while other drawing (Fig. 2) indicates that one mold piece can be a lot larger than the other mold piece. The court has held that drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Furthermore, a side-by-side comparison of Shimada and the current invention indicates that the mold pieces are proportional to each other or would fall with in the range of 52:48 to 66:34 ratio.

Fig.2



First embodiment from Shimada

Fig.1



First embodiment from the current application

Fig. 3(c)

Fig. 3(d)

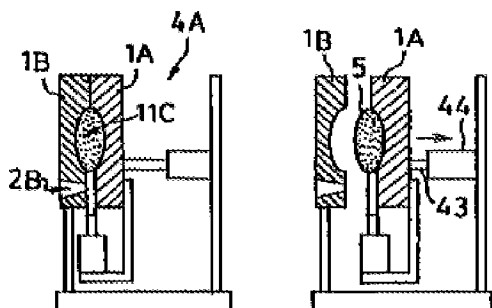
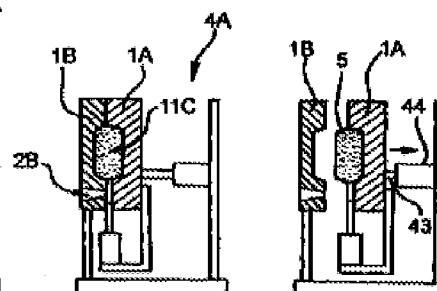


Fig. 2(c)

Fig. 2(d)



Second embodiment from Shimada

Second embodiment from the current application

In respond to Applicant's new admentment to the claims, Inoue et al (5,840,351) and Hobson are disclosed to show that split mold having split line/plan off center of the mold cavity are wellknown in the molding art.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THU KHANH T. NGUYEN whose telephone number is (571) 272-1136. The examiner can normally be reached on 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogendra N Gupta/  
Supervisory Patent Examiner, Art Unit 1791

TN